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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/786,169

02/26/2004

Andreas Hayden

080437.53242US

3465

23911 7590 06/27/2007
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EXAMINER

TO, TUAN C

ART UNIT

PAPER NUMBER

3663

MAIL DATE

DELIVERY MODE

06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/786,169	HAYDEN, ANDREAS	
	Examiner	Art Unit	
	Tuan C. To	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-25 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13, and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 8-13, and 15-20 in the reply filed on 04/20/2007 is acknowledged. The traversal is on the ground(s) that there is no serious burden on the examiner.

This is not found persuasive because the following:

Group I drawn to a process, Group II drawn to an apparatus, and that claimed apparatus can be used to practice a process of guiding a tourist traveling to a specified destination either using an audio guidance or text messages stored in a removable storage device. This shows that the invention I and I are distinct. In addition, the claimed apparatus control at least one control unit of a motor vehicle (see claim 14), therefore Group II is classified in class 701, subclass 70. Group I drawn to processing instruction within a processor (see claim 8). Therefore, Group I is classified in class 712, subclass 220.

MPEP 808 cites the reasons for insisting upon a restriction requirement. The examiner provided the reasons for restriction by showing the separate classification and the reasoning why said groups were restrictable (i.e, process/apparatus). The applicant argues that there is no serious burden placed on the examiner. This is not quite persuasive. Clearly, a burden exists when more than one invention is claimed and requires numerous class/subclass searches during the prosecution of this application.

The requirement is still deemed proper and is therefore made FINAL.

An action on claims 8-13, and 15-20 follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 8, and 15-20 are rejected under 35 U.S.C. 102 (b) as being anticipated by Ishiguro et al. (US 5949375A).

Regarding claims 8, and 15, Ishiguro et al. teaches a navigation system/method in which the program instructions are read out of a data carrier which is the CD-ROM, a ROM, a DVD, a floppy disk or the like (Ishiguro et al., figure 1; column 10, lines 4-10, programs instructions stored in the data carrier such as CD-ROM, DVD are read out by the present calculating apparatus 4), causing the system controller (4) (see figure 1) stores in the memory RAM (8) various data including route data, the ROM (7) stores control programs), the data stored on the data carrier such as CD-ROM, DVD, has been read out, wherein the stored data includes map data, control programs, etc (Ishiguro et al., column 12, lines 25-34).

Regarding claim 16, Ishiguro et al. teaches a method of inputting control unit data into a control unit in a vehicle comprising: reading by a reader unit, the control unit data

out of a data carrier (Ishiguro et al., figure 1; column 10, lines 4-10, programs instructions stored in the data carrier such as CD-ROM, DVD are read out by the present calculating apparatus 4), communicating the program instructions to the unit (4) via the data bus (9), storing the program instructions in a memory associated with the unit (4) (Ishiguro et al., figure 1, ROM 7, RAM 8). It is noted that the program instructions disclosed in Ishiguro et al. is a computer program instructions therefore they should be program code for sequence control.

As to claim 17, Ishiguro et al. teaches the on-board navigation system (Ishiguro et al., abstract).

As to claim 18, Ishiguro et al. teaches that data carrier comprises CD-ROM, DVD.

As to claim 19, Ishiguro et al. further teaches that data carrier contains control unit data (program instructions) applicable to a plurality of vehicles, and said act of reading is controlled by a microprocessor which reads vehicle characterizing information from a memory, and causes said reader unit to read from said carrier, only control unit data that are applicable to particular vehicle control units (Ishiguro et al., figure 1, the program instructions stored in the data carrier CD-ROM or DVD is read out via the CD-ROM drive (11) and are processed by the computer (4)).

As to claim 20, Ishiguro et al. further teaches: "characterizing information is stored in a memory maintained by a manufacturer of the vehicle (Ishiguro et al., column 12, lines 41-47, the ROM (7) is a volatile memory originally stores control program which is originally maintained by a manufacturer of the vehicle).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiguro et al. (US 5949375A) and in view of Brody (US 20010051928A1).

Ishiguro et al teaches the limitations of claim 8 except for "the control unit data stored on the data carrier is encrypted, the control unit data is protected against falsification". Brody teaches that the software stored on the data carrier such as CD-ROM is encrypted, the software is protected against falsification (Brody, paragraph 0013).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system/method as taught by Ishiguro et al. to include

the teachings of Brody in order to protect the software from unauthorized copying and distribution.

Response to Arguments

This is the communication in response to the applicant's election dated on 04/20/2007. The rejection has been revised in response to the applicant's election. Claim 14 should belong to group II since this is an apparatus claim. Claim 14 has been withdrawn from consideration as to not belong to the elected group I.

Conclusions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit: 3663

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Patent Examiner,

A handwritten signature in black ink, appearing to read 'Tuan C To', is written over a horizontal line. The signature is stylized with a large, sweeping 'T' and a long horizontal stroke extending to the right.

Tuan C To

June 21, 2007